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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,437	11/14/2003	J. Francois Eid	EID-P-1	7044
40636	7590	12/12/2005	EXAMINER	
AMS RESEARCH CORPORATION 10700 BREN ROAD WEST MINNETONKA, MN 55343			GILBERT, SAMUEL G	
			ART UNIT	PAPER NUMBER
			3735	

DATE MAILED: 12/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,437

Applicant(s)

EID, J. FRANCOIS

Examiner

Samuel G. Gilbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-6,8-12 and 17-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-27 is/are allowed.
- 6) ☒ Claim(s) 1,4-6,8-12 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Drawings

The drawings are objected to because Figure was has been amended to include item numbers 15 and 16. The amendments made to the drawings are inconsistent in that element –16- is supposed to show a linear handle section while in fact the lead line from element –16- is directed to one end of suture -14- and element –15- is supposed to show an outwardly angled shaft portion of the tool but the lead line is directed to a portion of the implant prosthesis between suture –14- and distal tip portion –13-. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 6, 8-12 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 - it is unclear how the convexity in the claimed range is measured. Would the applicant please explain how the convexity falls within the claimed range. The applicant amended the specification to say the width is .5 cm to about 1.5 cm.

Claim 6 – it is unclear to the examiner what structural difference is being set forth between the receptacle and the convex shaft as the specification and claims have been amended it appears that the receptacle and convex shaft are now the same element.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 4 and 5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention. The outwardly angled portion having a convexity and the linear handle section is aligned in spaced and parallel relation with the axis of the outwardly angled shaft section.

Specification

The amendment filed 11/14/2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: outwardly angled shaft section –15- is actually part of the implantable prosthesis and linear handle section –16- is actually one end of the suture.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6, and 8-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Mohamad(5,484,450).

Mohamad teaches a device as shown in figures 3 and 4, including a shaft -120-, handle -110-, and a receptacle -122- formed as part of the distal end of the shaft. The

receptacle (part of the shaft) has a convex surface designed to fit circumferentially about at least a portion of the implantable prosthesis. Applicant's attention is invited to column 3 lines 26-42.

Claim 8 - the receptacle can be fusiform as shown in Figure 5.

Claim 9 – the device has smooth edges and finish to protect against damage.

Claim 10 the receptacle is about 10mm in cross section, column 3, lines 5-12.

Claim 11 – the structure of the receptacle are capable of performing the recited intended use limitation

Claim 12 – the device of Mohamad is capable of performing the recited function.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mohamad(5,484,450) as applied to claim 6 above, in view of Furlow et al (4,244,370).

Mohamad teaches a device as shown in figure 5, including a shaft -120-, handle - 110-, and a receptacle -122-. Mohamad does not teach etched numbers and grooves to permit precise positioning of the prosthesis. Furlow et al teaches an implantation device having measurement calibrations -16- to allow proper positioning of the implant

and to prevent accidental perforations(set forth in Buckley(5,109,869). The examiner is taking official notice that it is old and well known to include numbers with calibration grooves. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include etched numbers and grooves on the device of Mohamed, including the handle, to allow the user to easily determine the depth of implantation and to prevent perforations as taught by Furlow et al and Buckley. Numbering the grooves allows the user to determine depth while the device is being used.

Allowable Subject Matter

Claims 1, 5 and 17-27 are allowed.

Claim 4 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

The arguments directed to claims 17-19 and 21-25 as anticipated by Fishell are persuasive and the rejections have been withdrawn.

The arguments directed to claims 1, 4 and 5 as unpatentable over Fishell in view of Thompson are persuasive and the rejections have been withdrawn.

The arguments directed to claims 6,9-10 and 12 –16 as unpatentable over Mohamad in view of Furlow et al have been considered but are moot in view of the new ground(s) of rejection. Further, the side by side lobe configuration is an embodiment

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shown in Figure 5 while a convex configuration is shown in Figures 3 and 4. Further surface -130- is capable of performing the recited function of contacting the implantable prosthesis.


The arguments directed to claims 6, 8, 10 and 11 as unpatentable over Fishell in view of Furlow et al are persuasive and the rejections have been withdrawn.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel G. Gilbert whose telephone number is 571-272-4725. The examiner can normally be reached on Monday-Friday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ali Imam can be reached on 571-272-4737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Samuel G. Gilbert
Primary Examiner
Art Unit 3735

SGG